

Section III:
AMENDMENT UNDER 37 CFR §1.121 to the
DRAWINGS

No amendments or changes to the Drawings are proposed.

Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Objections to the Specification

In the Office Action, an objection to the specification was made regarding application numbers on the first and second pages. The amendment herein removes the cross reference and incorporation to the related applications as those applications were ultimately filed subsequent to the present patent application.

In the Office Action, an objection to the specification was made regarding antecedent basis for the term "computer readable media" which appeared in independent Claim 6 and dependent claims 7 - 10 as originally filed. The term "computer readable medium" and its plural version "computer readable media" are well-known term in the art. These terms are recognized throughout USPTO literature and guidelines, such as at MPEP 2106.01, where it is specifically stated (emphasis added):

"... When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory)."

Applicants have similarly disclosed example embodiments comprising software stored on, in, or encoded by computing platforms (paragraph [0034]) which include memory and/or disks (paragraphs [0037], [0038]). Such software can also be received by a computing platform via an interface, such as a LAN or wireless interface (paragraphs [0039] - [0040]).

Whereas the term "computer readable medium" is well-known in the art, well-recognized

by the USPTO, and whereas sufficient examples of embodiments comprising computer readable media are specifically recited in applicants' disclosure, there is sufficient antecedent basis to support the term's use in claims. Withdrawal of the objection is respectfully requested.

Rejections under 35 U.S.C. §101

In the Office Action, Claims 6 - 10 were rejected under 35 U.S.C. §101 for being directed towards non-statutory subject matter, specifically for not being "tangibly embodied".

Independent Claim 6 has been amended to specifically recite an article of manufacture (e.g. a programmed or encoded computer readable medium) which is produced through encoding software on or in a computer readable medium, where specific functionality imparted by the software is further specified.

Such an article of manufacture is also a composition of matter, wherein such encoding process typically involves magnetic, electrical, mechanical, optical, or other physical transformation of a medium in order to store the software.

For these reasons, Claims 6 - 10 are directed towards at least two statutory categories of subject matter. Applicants respectfully request withdrawal of the rejections of Claims 6 - 10.

Rejections under 35 U.S.C. §103

In the Office Action, claims 1 - 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Published Patent Application 2004/0143430 to Said, *et al.* (hereinafter "Said"), in view of US Patent 6,876,728 to Kredo, *et al.* (hereinafter "Kredo").

A proper *prima facie* case of obviousness has not been established because (a) it has not been established that one of ordinary skill in the art would have had access to the disclosures of Said and Kredo simultaneously at the time applicants' invention was made and thus would not have been enabled to make the proposed combination, and (b) it has not been established that Said is prior art.

Access by Those Skilled in The Art. In order for the proposed combination to render applicants' claims obvious, both the disclosures of Said and Kredo relied upon for the combination must have been available to one of ordinary skill in the art at the time the applicants' invention was made. The following table chronologically sets forth the relevant events and filing dates of the cited art and applicants' patent application.

Chronology of Said, Kredo and the Applicant's Patent Application

| | <u>Date</u> | <u>Event</u> |
|------|-------------|------------------------------------------------------------------------------------------------------------------------------------------|
| (A) | 7/2001 | Kredo's Non-Provisional Patent Application (NP-PA) is filed. |
| (B) | 10/2002 | Said's Provisional Patent Application (PPA) is filed. |
| (C)* | | <u>Period during which neither Said's or Kredo's disclosure are publicly available, so no combination could have occurred by anyone.</u> |
| (D) | 1/2003 | Kredo's Pre-Grant Patent Application Publication occurs (PG-Pub). |
| (E)* | | <u>Period during which only those familiar with Said's unpublished PPA could have had access to Kredo's PG-Pub.</u> |
| (F) | 9/2003 | Applicants' Patent Application filed. |
| (G) | 10/2003 | Said's Non-Provisional Patent Application (NP-PA) is filed. |
| (H) | 7/2004 | Said's Pre-Grant Patent Application Publication occurs (PG-Pub). |
| (I) | 4/2005 | Kredo's patent issues. |

From this chart, it is readily apparent that during periods (A) through (C), the proposed combination could not have been made because both Kredo and Said were unpublished. Separately, these references fail to teach all of the claimed elements, and without their coincident or simultaneous availability, one skilled in the art could not have been motivated or enabled to make the proposed combination.

Following the publication of Kredo's pending patent application (D), a period of time (E) existed between 1/2003 and the applicants' filing date 9/2003 (F) in which only those familiar with Said's unpublished provisional patent application would have had access to the contents of

both the Said reference and the Kredo reference. Those familiar with the Kredo reference (e.g. patent practitioners, inventors, etc.) would not have had access to the details of the Said reference because it had not been published yet, nor would have any other persons other than those familiar with the Said application.

All events (G, H, I) following applicants' filing date (F) are irrelevant because the formulation of a *prima facie* case of obviousness relies upon what one of ordinary skill in the art would have been enabled and motivated to do at the time the applicants' made their invention.

So, a critical analysis must be made of those persons familiar with the details of Said's unpublished provisional patent application during time period (E) because this is the only time prior to or at the time of applicants' invention and the only persons who would have had access to both references. Other persons would not have had access to both references, and thus could not have been enabled or motivated to make the proposed combination.

Who was familiar with the Said provisional patent application (PPA) disclosure? At least the inventors were aware of the details, as would have been the representing attorney. But, are each of these three persons "ordinarily skilled", or would they have been more skilled than "ordinary". If only those of a high level of skill in the art had access to the relied upon references, then there could have been no motivation of anyone of ordinary skill in the art to make the propose combination, according to analysis by the Federal Circuit (see *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453, 1458, 1459 (Fed. Cir. 1998)).

- (1) Mr. Joe P. Said is a named inventor on two issued patents and three published patent applications, the earliest of which was filed in march of 1998, placing him as an inventor in the art for at least five years at the time of the applicants' present invention. Further, according to zoominfo.com, Mr. Said co-founded a company, gh LLC, in March of 2000, as its President and CEO, after several impressive, high-tech successes at Purdue University. Applicants submit that, at the time of filing the present patent application by applicants in late 2003, Mr. Said was of a high-level of skill in the art.
- (2) Said's co-inventor, Mr. David A. Schleppenbach, is also presently named as an inventor on two issued patents and three published US patent application, in which the earliest was filed in March 1998. Further, according to zoominfo.com,

Mr. Schleppenbach was 32 years old in 2004, and co-founded gh LLC, with Mr. Said, and likewise had a distinguished graduate student career at Purdue University. Applicants submit that, at the time of filing the present patent application by applicants in late 2003, Mr. Schleppenbach was of an extraordinarily high level of skill in the art.

- (3) Without access to the actual Said Provisional Patent Application, applicants' cannot determine if an attorney or agent would have been familiar with the PPA's details. However, Mr. Charles C. Valauskas is listed on the published patent application, who is a registered patent attorney with the USPTO since 1985, which would presumably place him as a person having an extraordinarily high level of skill in the art.

As such, there are no other persons known who would have had access to both the details of Said's provisional patent application and Kredo's pre-grant published patent application, and therefore no persons of ordinary skill in the art could have been enabled or motivated to make the proposed combination.

Applicants submit that an ordinary level of skill in the relevant arts would be 4 - 6 years of relevant software engineering experience, including an equivalent of a Bachelors of Science degree in communications systems, software, or both, according to the statistics for 2004 offered by the Bureau of Labor Statistics, correlated to job descriptions provided by salary.com after adjusting for inflation since 2004.

Applicants respectfully request withdrawal of these rejections, or for the examiner to establish for the record the level of ordinary skill in the art at the time of applicants' invention assumed for the purposes of examination. *In re Gentile*, Civ. App. No. 98-1086 (Fed. Cir. Oct. 5, 1993) (unpublished)

Establishing the Said Reference As Prior Art. In the rationale for the rejections, Said's pre-grant published patent application number 2004/0143430 (PG-Pub) was relied upon in the proposed combination under 35 U.S.C. §103(a). However, the filing date of Said's non-provisional patent application is October 15, 2003, which falls *after* applicants' filing date of September 25, 2003.

Although it is not explicitly stated in the Office Action, presumably the examiner is affording the relied-upon portions of Said's PG-Pub the filing date of Said's provisional patent application (PPA), which was October 15, 2002.

Applicants are unable to verify that these portions are indeed entitled to such a priority date because provisional patent applications are not published, and are not available in the Image File Wrapper of the non-provisional application.

As such, applicants submit that the published patent application 2004/0143430 does not qualify as prior art unless it is established for the record that the corresponding provisional patent application contains supporting *and enabling* disclosure for the portions of disclosure relied upon in the rationale for the rejections. Further, any disclosure relied upon for *motivation* to make the proposed combination must also be supported by the provisional patent application.

Applicants respectfully request withdrawal of the rejections on the basis that Said does not qualify as prior art. Alternatively, if the Said reference is relied upon for subsequent rejections, Applicants request a copy of the relied-upon provisional patent application.

Conclusion

Applicants respectfully request allowance of all claims as amended.

Respectfully submitted,

/ Robert Frantz /

Robert H. Frantz, Reg. No. 42,553
Agent for Applicant(s)
Tel: (405) 812-5613
Franklin Gray Patents, LLC